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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,386	04/14/2004	Mordechay Hershkovitz	1662/63402	8459

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EXAMINER	
DAVIS, BRIAN J	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/825,386	HERSHKOVITZ ET AL.	
	Examiner	Art Unit	
	Brian J. Davis	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-21,23,24,26-41,43,45-59,61-63,66-69,71,72,74 and 75* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-7,9-21,43,45-59,61,62,66-69,71,72,74 and 75* is/are allowed.

6)☒ Claim(s) *23,24,26-41,63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections Withdrawn

The objections to claims 20, 33 and 50, outlined in the previous Office Action, have been overcome by applicant's amendment. The amendment corrects the claim text as appropriate.

The objection to claim 64, as being dependent upon a rejected base claim but otherwise allowable, has been overcome by applicant's amendment. The amendment cancels the claim.

112 Rejections Withdrawn

The rejection of claims 1-60 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment.

With respect to claims 1, 23, 37 and 43, the amendment clarifies the claim language as appropriate. With respect to claims 8, 25 and 44, the amendment cancels the claims. Claims 22, 42 and 60 have also been canceled. With respect to the remaining claims, the rejection is moot.

102 Rejections Withdrawn

The rejection of claims 22, 42, 60, 65, 70, 73, 76-78 and 87 under 35 USC 102(b), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels the claims.

The examiner notes for clarity of the record that applicant refers only to claim 86 (rather than claim 87) as the highest numbered claim in the application with respect to this rejection, however, this appears to be an obvious editorial error.

103 Rejections Withdrawn

The rejection of claims 79-86 under 35 USC 103(a), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels the claims.

103 Rejections Maintained

The rejection of claims 23, 24 and 26-41 (claim 25 having been canceled) and 63 under 35 USC 103(a), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments have been carefully considered, but are not persuasive.

The examiner is in perfect agreement with applicant as to the criteria defining a legal definition of obviousness. However, contrary to applicant's assertion, the examiner respectfully maintains that those criteria were fulfilled. A detailed analysis follows.

The key to this set of claims remains the choice of reactor: trickle-bed.

With respect to the rejection of claim 23 over 4,536,518, applicant maintains that the "[u]se of a trickle-bed reactor differs from use of a batch reactor [of the cited prior art] in that the trickle-bed reactor allows for continuous reaction." While certainly true,

this is still not a patentably distinct feature, as the pertinent case law confirms: It is well established that batch and continuous processes are not patentably distinct. See, for example, *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963).

Applicant also maintains that a trickle-bed reactor has certain advantages with respect to catalyst exploitation – with which the examiner is in perfect agreement with applicant. And that this type of reactor "is more economical than the batch reactor, and, thus, more desirable for industrial application." And again, the examiner is in perfect agreement with the applicant.

However, a reference need not disclose what is well known in the art. *In re Myers*, 410 F.2d 420, 424, 161 USPQ 668, 671 (CCPA 1969). That is, a reference need not disclose that one of ordinary skill in the art would find it obvious to choose the most economical reactor setup for a given reaction. A trickle-bed reactor is an example of off-the-shelf reactor technology. It is not a new or novel technique and applicant would find motivation to choose it from among other alternatives for just such a reason as applicant cites: economic.

Applicant also maintains that the examiner has misapplied *In re Leum* (cited in full in the original rejection) with respect to the choice of reactor, since the fact pattern of the instant application and that of the case law do not correspond. However, the examiner respectfully disagrees and suggests that if case law were consistently interpreted and applied as narrowly as applicant has interpreted and applied it, then no case law could ever be cited for guidance, since the fact patterns of any cited case and any given application would never maintain an exact one-to-one correspondence.

In re Leum refers specifically to pressure, granted. But the broader conclusions drawn from such a case mesh with the conclusions of a host of other case law where improvements to known reactions also do not constitute patentable improvements absent some showing of criticality or unexpected results, for instance: It is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. *In re Becket*, 33 USPQ 33 (CCPA 1937). *In re Russell*, 439 F2d 1228, 169 USPQ 426 (CCPA 1971); Merely modifying process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955); Merely reversing the order of steps in a multi-step process is not a patentable modification absent unexpected or unobvious results. *Ex parte Rubin*, 128 USPQ 440 (POBA 1959); *Cohn v. Comr. Patents*, 251 F. Supp. 437, 148 USPQ 486 (DC 1966) ; etc.

Analysis of the remaining claims and cited art is similar.

Allowable Subject Matter

Claims 1-7, 9-21, 43, 45-59, 61, 62, 66-69, 71, 72, 74 and 75 remain allowed for reasons of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
June 19, 2006